



Attorney Docket No. 213839-00013

RECEIVED
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TECH CENTER 100013330

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: McCafferty, *et al.*

Serial No.: 09/726,219

Filed: November 28, 2000

Title: Methods for Producing
Members of Specific Binding
Pairs

Group Art Unit: 1627

Examiner: P. Ponnaluri

CERTIFICATE OF MAILING

I hereby certify that this paper is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop DD, Commissioner for Patents, Alexandria, VA 22313-1450, on this date.

05/05/03
Date

David W. Clough, Ph.D.
Registration No. 36,107

**FIRST SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT
PURSUANT TO 37 C.F.R. § 1.97-1.99
FILED WITH PETITION TO EXPUNGE
PURSUANT TO 37 C.F.R. § 1.59**

Mail Stop DD
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Information Disclosure Statement is being submitted pursuant to the applicants' duty of candor and in particular to the applicants' duty to disclose, under MPEP §2001.06(c), information from related litigation such as the charges of inequitable conduct in the parent of the present application, now U.S. Patent No. 5,969,108 (the '108 patent). Applicants request that the documents listed on the attached Form PTO/SB/08A be made of official record in the above-identified application and considered by the Examiner. Our check in the amount of \$180 is also enclosed pursuant to 37 C.F.R. § 1.17(p).

Some of the documents being submitted are subject to a protective order in Civil Action No. 1:00 CV 00146 and are being submitted in a sealed, clearly labeled envelope for consideration under MPEP § 724. A Petition to Expunge under 37 C.F.R. § 1.59, along with

The PTO did not receive the following listed item(s)

the fee of \$130 pursuant to 37 C.F.R. § 1.17(h) are also enclosed herewith. If the submitted documents are found not to be important in deciding whether to allow the application to issue as a patent, applicants respectfully request that the Petition to Expunge under 37 C.F.R. § 1.59 be granted and the documents identified below be returned to the attorney for applicant.

1. Agreement between Medical Research Council, Cambridge Antibody Technology Limited and Cambridge Antibody Technology Group plc, dated 1/7/97 (financial terms redacted);
2. Chiswell memo, dated July 30, 1990, transmitting a copy of the Collaborative Agreement between Cambridge Antibody Technology and The Medical Research Council, dated July 27, 1995; and
3. Administration Agreement between Cambridge Antibody Technology Ltd. and Medical Research Council, 8/1/91 (financial terms redacted).

This same Supplemental Information Disclosure Statement is being filed simultaneously in related application nos. 09/196,522; 09/196,673; 09/309,639; 09/416,902; 09/196,586; 09/417,479; 09/706,507; and 09/726,219. Each of these related applications is currently under examination by Examiner Ponnaluri. In view of the filing of the Petition to Expunge, applicants are transmitting a single copy of the cited references for consideration in each of the related applications.

**Inequitable Conduct Allegations Involving
U.S. Patent No. 5,969,108 (parent of the present application)**

The following is a brief summary of the allegations being made by MorphoSys AG with respect to inequitable conduct in obtaining the '108 patent. MorphoSys has alleged inequitable conduct on the part of Cambridge Antibody Technology Limited, ("CAT"), one of the assignees of the '108 patent, in obtaining the '108 patent. The subject matter claimed in the '108 patent generally relates to the display of single chain antibodies on the surface of filamentous bacteriophage.

One of the bases for the allegation of inequitable conduct is that the applicants did not disclose to the U.S. Patent & Trademark Office a National Institute's of Health ("NIH") grant application by Dr. George Smith relating to the display of small peptides on the surface of phage and which contains a prophetic disclosure of the display of single chain antibodies on the surface of phage which Dr. Smith characterized as speculative in the text of the grant.

Documents (including deposition testimony) submitted herewith relate *inter alia* to the specific allegations made by MorphoSys with regard to this issue, including communications between CAT personnel and their attorneys relating to their knowledge of the existence and public availability of the Smith grant application, and the allegedly cumulative nature of the application in view of what was already before the Patent Office and Dr. Smith's own characterization of what would constitute the invention of the display of single chain antibodies on phage made in a "Declaration" several years after his receipt of the NIH grant.

There is disagreement between CAT and MorphoSys regarding *inter alia* the actual public availability of a Smith grant application, its alleged cumulative and speculative nature in view of material already before the U.S. Patent & Trademark Office and the problems cited by Dr. Smith in his discussion of the display of single chain antibodies on phage in the grant application.

An allegation has also been made that CAT engaged in inequitable conduct by not disclosing to the Patent Office the Smith grant application as relevant to rebut arguments made to the PTO that the art taught away from the display of large peptides on the surface of phage. Nevertheless, the Examiner of the '108 case found that the applicants' arguments regarding that issue had already been rebutted by U.S. Patent No. 5,427,908 to Dower *et al.*, which was already of record in that case and is of record in the present application.

MorphoSys has further alleged that CAT has committed inequitable conduct for their alleged failure to point out the inventor and invention date of each claim that was not commonly owned by CAT and The Medical Research Council ("MRC"), both assignees of the '108 patent, at the time a later invention was made to allow consideration of the applicability of 35 U.S.C. §102(f) or (g) prior art under 35 U.S.C. § 103(a). MorphoSys alleges that CAT has failed to show that the subject matter and the claims were, at the time the invention was made, commonly owned. CAT's position supported by deposition testimony (attached herewith) is that there was a clear understanding that the subject matter of each and every claim was commonly owned at all times and the later written agreements submitted herewith simply memorialized the basic understanding between CAT and MRC.

The following documents are being submitted herewith which were recently filed, held or are relevant to the litigation involving the parent of this application in the U.S.

District Court District of Columbia (U.S. District Court, District of Columbia, Civil Action No. 1:00 CV 00146).

1. First Amended Complaint, filed March 8, 2002;
2. Cambridge Antibody Technology Limited's Answer to First Amended Complaint, filed March 22, 2002;
3. Redacted Agreement between Medical Research Council, Cambridge Antibody Technology Limited and Cambridge Antibody Technology Group plc, dated 1/7/97 (**Subject to the Petition to Expunge**);
4. Deposition Transcript of David W. Clough, taken April 19, 2002;
 - a. E. I. du Pont de Nemours & Co. v. Cetus Corp., 19 USPQ2d 1174, (DC D/ N.Cal. 1990) cited in Deposition Transcript of David W. Clough, taken April 19, 2002;
 - b. OddzOn Products Inc. v. Just Toys Inc., 43 USPQ2d 1641 (CAFC 1997), cited in Deposition Transcript of David W. Clough, taken April 19, 2002;
5. Deposition Transcript of George P. Smith, Ph.D., taken May 14, 2002;
6. Deposition Transcript of Dr. David Chiswell, taken April 29, 2002;
7. Deposition Transcript of Dr. Gregory Paul Winter, taken April 30, 2002;
8. Volume I – Deposition Transcript of Sean Malcolm Walton, taken May 1, 2002;
9. Volume II – Deposition Transcript of Sean Malcolm Walton, taken May 2, 2002;
10. Chiswell memo, dated July 30, 1990, transmitting a copy of the Collaborative Agreement between Cambridge Antibody Technology and The Medical Research Council, dated July 27, 1995 (**Subject to the Petition to Expunge**);
11. Declaration of George P. Smith Under 37 C.F.R. § 1.132, executed June 30, 1995 (submitted during the prosecution of U.S. Application No. 08/322,352);

12. Declaration of Professor Brian K. Kay, Ph.D., executed June 28, 1998 (submitted during the prosecution of European Patent Application No. 91913039.3);
13. Abstract of George P. Smith Grant No. 1R01GM41478-01A1.
14. Smith Grant Application, dated November 1, 1988; and
15. Administration Agreement between Cambridge Antibody Technology Ltd. and Medical Research Council, 8/1/91 (**Subject to the Petition to Expunge**).
16. Fax from John McCafferty (of Cambridge Antibody Technology Limited) to S. Walton (of Mewburn Ellis) Re: Smith Grant Application.
17. E-mail message from John McCafferty (of Cambridge Antibody Technology Limited) to Brian Kay Re: Smith Grant Application.
18. Letter from John McCafferty (of Cambridge Antibody Technology Limited) to Craig Palmer (of Academic Press) Re: Smith Grant Application.
19. Fax to John McCafferty (of Cambridge Antibody Technology Limited) from Craig Panner (of Academic Press) dated June 10, 1996.
20. Smith, G. P., "1988 – A Year of Discovery", *Phage Display of Peptides and Proteins*, Academic Press, Inc. (1996), pp. xvii-xix.
21. Northern Telecom Inc. v. Datapoint Corp., 15 USPQ 1321 (CAFC 1990).

Documents 1-12 and 15 are individually listed below with cites to the relevant testimony.

First Amended Complaint, filed March 8, 2002

Page	Line	
6	1	Allegations regarding Smith grant/
thru		inequitable conduct
21	12	

**Cambridge Antibody Technology Limited's
Answer to First Amended Complaint, filed March 22, 2002**

Page	Line	
7	8	Response to allegations regarding Smith grant/ inequitable conduct
thru		
29	22	

Deposition Transcript of David W. Clough, taken April 19, 2002

Page	Line	
21	10	Testimony regarding Smith grant
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25	10;	
27	1-15;	
29	10	
thru		
32	24;	
33	11	
thru		
40	20;	
46	4-10;	
55	22	
thru		
57	16;	
65	10	
thru		
66	14;	
68	10	
thru		
84	24;	
88	20	
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95	5;	
96	16-19;	
97	22	
thru		
99	6;	
100	15-24;	
101	12-21;	
102	22	
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Deposition Transcript of David W. Clough, taken April 19, 2002 (Continued)

Page	Line	
105	13	Testimony regarding Smith grant
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108	4;	
108	13-22;	
109	14-20	
111	1	
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112	3;	
123	3-15;	
125	1	
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131	2;	
131	12	
thru		
132	8;	
141	12-15;	
142	3-15;	
148	9	
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152	7;	
153	10	
thru		
154	14;	
155	14	
thru		
156	9;	
176	8-24	
105	13	Testimony regarding '96 knowledge of Smith grant
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109	20	
171	15	
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175	12	
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176	18	Testimony regarding DuPont v. Cetus
thru		
177	20	
Page	Line	
179	14-15	Testimony regarding Oddzn Products v. Just Toys Inc.

Deposition Transcript of George P. Smith, Ph.D., taken May 14, 2002

Page	Line	
31	8	Testimony regarding Smith grant
thru		
39	17;	
40	4	
thru		
49	15;	
50	25	
thru		
53	25;	
61	20	
thru		
62	12;	
64	5	
thru		
65	25;	
67	6	
thru		
68	8;	
92	1-22;	
100	24	
thru		
101	13;	
104	10-17;	
106	12-21;	
111	7	
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112	12;	
132	12-25;	
141	21	
thru		
142	16;	
143	14	
thru		
146	25;	
148	23	
thru		
149	1;	
155	14-22;	
157	8	
thru		
158	4;	
162	8-20;	

Deposition Transcript of George P. Smith, Ph.D., taken May 14, 2002

Page	Line	
166	10	Testimony regarding Smith grant
	thru	
167	12;	
183	2-23.	

Deposition Transcript of Dr. David Chiswell, taken April 29, 2002

Page	Line	
119	23	Testimony regarding Smith grant
	thru	
124	1;	
128	5	
	thru	
129	5;	
204	19	
	thru	
209	22	

Page	Line	
37	2	Testimony regarding Chiswell memo
	thru	
66	4;	
94	17	
	thru	
96	2	

Page	Line	
None		Testimony regarding '96 knowledge of Smith grant

Page	Line	
157	7	Testimony regarding common ownership
	thru	
158	17;	
215	19	
	thru	
219	15	

Deposition Transcript of Dr. Gregory Paul Winter, taken April 30, 2002

Page	Line	
123	11-14;	Testimony regarding Smith grant
130	22	
	thru	
139	14.	

Page	Line	
None		Testimony regarding '96 knowledge of Smith grant

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74	1	Testimony regarding common ownership
	thru	
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79	16	
	thru	
80	16	
82	1-11	
181	18	
	thru	
182	24	
222	3	Testimony regarding common ownership

	thru	
225	13	

Volume I

Deposition Transcript of Sean Malcolm Walton, taken May 1, 2002

Volume II

Deposition Transcript of Sean Malcolm Walton, taken May 2, 2002

Page	Line	
16	8	Testimony regarding Smith grant
	thru	
18	2;	
31	20	
	thru	
59	23;	
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	thru	
91	6;	

Volume I
Deposition Transcript of Sean Malcolm Walton, taken May 1, 2002
Volume II
Deposition Transcript of Sean Malcolm Walton, taken May 2, 2002
(Continued)

Page	Line	
93	25	Testimony regarding Smith grant:
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95	9;	
95	19	
	thru	
96	4;	
97	19	
	thru	
106	21;	
108	14	
	thru	
109	23;	
110	12	
	thru	
111	1;	
132	17-23;	
133	15	
	thru	
140	25;	
165	21	
	thru	
166	18;	
170	1-9;	
173	16	
	thru	
176	11;	
199	6	
	thru	
208	23;	
228	11-13;	
230	8-16;	
231	7-9;	
232	25	
	thru	
243	22;	
246	16	
	thru	
247	10;	

Volume I
Deposition Transcript of Sean Malcolm Walton, taken May 1, 2002
Volume II
Deposition Transcript of Sean Malcolm Walton, taken May 2, 2002
(Continued)

Page	Line	
249	23	Testimony regarding Smith grant:
thru		
257	22;	
267	5	
thru		
268	18;	
270	21	
thru		
277	22;	
285	2	
thru		
289	19;	
321	24	
thru		
322	13;	
322	18-23;	
323	5	
thru		
328	11	

Page	Line	
82	17	Testimony regarding '96 knowledge of Smith grant:
thru		
90	8;	
95	19	
thru		
96	4;	
97	19	
thru		
101	5;	
103	3	
thru		
106	21;	
108	14	
thru		
111	1;	

Volume I
Deposition Transcript of Sean Malcolm Walton, taken May 1, 2002
Volume II
Deposition Transcript of Sean Malcolm Walton, taken May 2, 2002
(Continued)

Page	Line	
133	15	Testimony regarding '96 knowledge of Smith grant:
	thru	
140	25;	
205	5	
	thru	
208	23;	
271	19	
	thru	
277	22;	
285	2	
	thru	
289	19; and	
321	24	
	thru	
328	11	
Page	Line	
179	22	Testimony regarding common ownership:
	thru	
184	17;	
186	16	
	thru	
191	8;	
192	22	
	thru	
195	19	

Chiswell memo, dated July 30, 1990,
(transmitting a copy of the Collaborative Agreement between Cambridge Antibody
Technology and The Medical Research Council, dated July 27, 1995)
(Subject to Petition to Expunge)

Declaration of George P. Smith Under 37 C.F.R. § 1.132

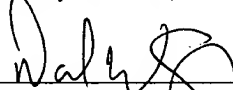
Page	Line	
2	7-9;	Inequitable conduct
4	3-9	

Finally, attorney for applicants submit herewith a reference (Il'ichev, A.A., *et al.*, "M13 Filamentous Bacteriophage in Protein Engineering", *Molekulyarnaya Biologiya*, Vol. 24, No. 2, pp. 530-535, (March-April 1990)(two versions – one in Russian (with a one-page abstract) and a translation of the same reference) and a patent which were recently brought to applicants' attention.

In addition, a copy of the references cited made necessary by ongoing proceedings in the European Patent Office in connection with a relative European application, which were brought to our attention less than three months prior to the filing of this Information Disclosure Statement.

The Commissioner is hereby authorized to charge any additional fees which may be required in this application under 37 C.F.R. §§1.16-1.17 during its entire pendency, or credit any overpayment, to Deposit Account No. 50-1214. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-1214.

Respectfully submitted,



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May 5, 2003
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